

IN THE DRAWINGS:

The three (3) attached sheets of three (3) drawings include changes to Figures 1-3. Figures 1-3 have been amended to show appropriate cross-hatching. Accordingly, Applicants respectfully request the Examiner's reconsideration and withdrawal of the objection to the drawings.

REMARKS

I. STATUS OF THE CLAIMS

By the present amendment, Applicants cancel claims 52 and 53, and amend claims 35 and 66 to incorporate the limitations of the canceled claims. Claim 54 has been amended to correct its dependency. Accordingly, claims 35-51 and 54-68 are pending in this application. Applicants submit that no new matter has been introduced by these amendments.

II. REJECTIONS UNDER 35 U.S.C. § 102

The Examiner has rejected claims 35-41, 43, 51-52, and 56-68 under 35 U.S.C. § 102(b) as being anticipated by WO 98/52197 ("Belli et al.") for the reasons disclosed at pages 3-7 of the Office Action. The Examiner also rejected claims 35, 43, and 44-51 as being anticipated by JP 09-035544 ("Hayashi") for the reasons disclosed at pages 7-8 of the Office Action. Applicants respectfully traverse these rejections for at least the following reasons.

A rejection under Section 102 is proper only when the claimed subject matter is identically described or disclosed in the prior art. In re Arkley, 455 F.2d 586, 587 (C.C.P.A. 1972). "For anticipation under 35 U.S.C. § 102, the reference must teach every aspect of the claimed invention either explicitly or impliedly." M.P.E.P. § 706.02. As recognized by the Examiner, neither Belli et al. nor Hayashi teach or suggest an electric cable in which the "expanded polymeric material is obtained from a polymeric

material that, before expansion, has a flexural modulus at room temperature, measured according to ASTM Standard D790, not greater than 200 MPa."

For at least this reason, these references fail to anticipate the claims and the present rejections should be withdrawn.

III. REJECTIONS UNDER 35 U.S.C. § 103

A. The Examiner has rejected claims 53-55 under 35 U.S.C. § 103 as being unpatentable over Belli et al. for the reasons given at page 10 of the Office Action. Applicants respectfully traverse this rejection.

As discussed above, Belli et al. fails to teach or suggest an electric cable in which the "expanded polymeric material is obtained from a polymeric material that, before expansion, has a flexural modulus at room temperature, measured according to ASTM Standard D790, not greater than 200 MPa," as recited in amended, independent claim 35.

The Examiner has asserted "it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the insulated cable of Belli to comprise the flexural modulus to be less than 200 MPa, specifically between 10-150 MPa, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art." Office Action at 10. Applicants respectfully disagree with the Examiner.

First, Belli et al. specifically directs a person of ordinary skill in the art to an expanded polymer material with a flexural modulus "greater than 200 MPa, preferably between 400 MPa and 1500 MPa." See page 7, lines 23-30 of Belli et al. Belli et al.,

therefore, teaches a preference for greater values of flexural modulus and does not recognize the lower values. It is well-established that where the references *teaches away* “from the claimed invention is a significant factor to be considered in determining obviousness.” M.P.E.P. § 2145(X)(D).

Second, since Belli et al. does not recognize any value in a flexural modulus at room temperature not greater than 200 MPa, there is no evidence of a reasonable expectation of success. Rather, Belli et al. merely shows the possibility of success when the flexural modulus is only greater than 200 MPa.

Third, the Examiner’s reliance upon In re Aller is misplaced. The Examiner has not shown how a physical property, such as flexural modulus is remotely comparable to a process parameter such as temperature and concentration, which is what In re Aller is limited to. See M.P.E.P. § 2144.05(II)(A). Physical properties are commonly accepted as patentable limitations with respect to polymers. *E.I. Du Pont de Nemours & Co. v. Phillips Petroleum Co.*, 7 U.S.P.Q.2d 1129, 1133 (Fed. Cir. 1988) (“[o]n occasion, particularly with polymers, structure alone may be inadequate to define the invention, making it appropriate to define the invention in part by property limitations.”)

Fourth, the Examiner has not shown that the pre-conditions for making the argument with respect to In re Aller are present. The Examiner has asserted that it would have been obvious to discover the optimum or workable ranges for flexural modulus. The M.P.E.P. explains that “a particular parameter must be recognized as a result-effective variable, i.e., a variable which achieves a recognized result, before the determination of the optimum or workable ranges of said variable might be

characterized as routine experimentation." M.P.E.P. § 2144.05(II)(B). Accordingly, since Belli et al. does not recognize a flexural modulus less than 200 MPa and does not teach that the flexural modulus achieves a recognized result, the M.P.E.P. dictates that the Examiner's argument regarding In re Aller **CANNOT** be used as a basis for obviousness. See *id.*

For at least the above reasons, Applicants respectfully submit that claim 35, which incorporates the limitations of claim 53, and claims 54 and 55 are patentable over Belli et al.. Applicants respectfully request withdrawal of the pending rejection.

B. The Examiner has rejected claim 42 under 35 U.S.C. § 103 as being unpatentable over Belli et al. as applied above to claims 35-41, and 43-68, in view of European Pat. No. EP 0 271 990 ("Yamamoto"), for the reasons given at pages 9-10 of the Office Action. Applicants respectfully traverse this rejection.

As discussed above, Belli et al. fails to teach or suggest an electric cable in which the "expanded polymeric material is obtained from a polymeric material that, before expansion, has a flexural modulus at room temperature, measured according to ASTM Standard D790, not greater than 200 MPa," as recited in amended, independent claim 35. Yamamoto also does not teach or suggest this claim limitation.

Furthermore, as discussed above, there is no evidence of record of any motivation to modify Belli et al. to correct this deficiency. The Examiner's argument regarding obviousness of ranges if inapplicable, according to M.P.E.P. § 2144.05(II)(B)

under the present facts. In addition, there is no evidence of a reasonable expectation of success, since Belli et al. has not considered a flexural modulus "greater than 200 MPa.

For at least the above reasons, Applicants respectfully submit that claim 35 is in condition for allowance, as is claim 42 at least by virtue of its dependence from allowable claim 35. Accordingly, Applicants respectfully submit that claim 42 is patentable over Belli et al. and Yamamoto.

IV. CONCLUSION

In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims. Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account no. 06-0916.

Respectfully submitted,

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By: _____


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